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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,669	04/30/2001	Brian James Clark	26548-0007	2276

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EXAMINER

GREIMEL, JOCELYN

ART UNIT PAPER NUMBER

3693

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/845,669

Applicant(s)

CLARK ET AL.

Examiner

Jocelyn Greimel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This Non-final rejection is in response to Applicant's Amendments filed August 08, 2006. Claims 35-83 are currently pending in the application. Claims 1-34 were cancelled in a Preliminary Amendment. Claims 35, 50 and 68 are independent claims.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Regarding claims 35, 50 and 68, the phrase "substantially equal" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "substantially equal"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Appropriate correction is required.

4. Claims 35, 50 and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase "upon the occurrence of a predetermined event" is inconsistent with the preceding claim terminology. A suggested correction would be the use of the phrase "predetermining an event" which is more clear. Additionally, the claim language must disclose the outcome "if the amount credited based on the index-linked earnings is not equal to at least the annual

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guarantee" in addition to the outcome if the earnings is equal to at least the annual guarantee. This other outcome should take the form of an additional step to claim 35. Appropriate correction is required.

***Response to Amendment***

5. Applicant's arguments regarding:

(1) "estimating the cost of the annual guarantee at the start of the term period, where the estimated cost of the annual guarantee accounts at least partially for the risk of the hedged investment not outperforming the annual guarantee"

(2) "if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value)"

of claims 35, 50 and 68 have been considered but are moot in view of the new grounds of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 35, 50 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne and Schirripa, and further in view of Mody. Mody teaches:

- b. Paying a fee for a guarantee
- c. Estimating the cost of the annual guarantee at the start of the term period
- d. Where the estimated cost of the annual guarantee accounts at least partially for the risk (pages 4-5, 8-9).

Payne teaches the method, system and implementation of a index-linked insurance product having a term and an annual guarantee. It would have been obvious to one skilled in the art at the time of the invention to have combined the insurance product of Payne with the fee for the guarantee of Mody as this feature would increase security for the issuing corporation. Both Payne and Mody disclose financial entities applicable in the insurance and investment market.

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5. Claims 35, 50 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne and Schirripa, and further in view of Mody. Schirripa teaches:

- e. if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value) (col. 2, lines 14-45).

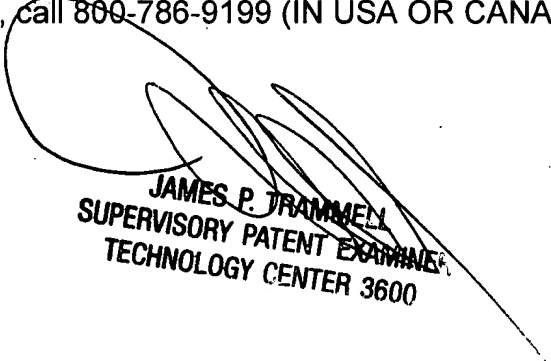
Schirripa teaches using funds from a risk fund to make payments that would be expected. Payne teaches the method, system and implementation of a index-linked insurance product having a term and an annual guarantee. It would have been obvious to one skilled in the art at the time of the invention to have combined the insurance product of Payne with the risk fund from Schirripa as this feature would increase use by clients because they would feel the continuity of payments would be secure.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Jocelyn Greimel  
Examiner, Art Unit 3693  
October 27, 2006